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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,499	10/26/2001	Richard W. Avery	J-3086	3101

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EXAMINER

DELCOTTO, GREGORY R

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 02/19/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/035,499

Applicant(s)

AVERY ET AL.

Examiner

Gregory R. Del Cotto

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 10-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-18 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-18 are pending.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, drawn to a hard surface cleaner, classified in class 510, subclass 421.
- II. Claims 10-18, drawn to a method of cleaning a hard surface, classified in class 134, subclass 42.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Group II are related as product and process of use.

The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the invention of Group I can be used in a materially different process such as in a method of cleaning skin.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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During a telephone conversation with Herbert W. Mylius on February 7, 2003, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-9. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4 and 6-9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lang et al (US 4,931,271).

Lang et al teach cosmetic compositions for the treatment of hair or skin which are distinguished by surprisingly advantageous characteristics containing N-hydroxybutyl-

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chitosan. See column 2, lines 30-69. The chitosan compounds are generally present from 0.05 to 10% by weight. Additionally, the compositions may also contain surfactants in amounts from 3 to 50% by weight and the pH value of the composition is generally in the range of 3 to 9 and more preferably 4 to 7. Suitable surfactants include anionic, nonionic, cationic, and amphoteric surfactants. See column 5, lines 10-65.

Specifically, Lang et al teach an anionic hair washing composition containing 1 g of chitosan, 40 g ether sulfate, 54.85 g water, etc. Also, Lang et al teach a hair washing composition containing 2 g chitosan, 40 g betaine, 5.06 g formic acid, 48.44 g water, etc. Additionally, Lang et al teach a composition containing 0.3 g chitosan, 1.48 g lactic acid, 2.5 g coconut(pentaethoxy)methyl ammonium chloride, 1 g sorbitanmonopalmitate ethoxylated with 20 moles ethylene oxide, and 90.72 g water. Furthermore, Lang et al teach a composition containing 2 g chitosan, 0.6 g hydroxypropylmethylcellulose, 0.5 g lauryl pyridinium chloride, and 96.8 g water. See column 11, line 40 to column 12, line 30. Note that, the Examiner asserts that the compositions specifically taught by Lang et al would inherently have the same pH as recited by the instant claims because Lang et al teach compositions containing the same components in the same proportions as recited by the instant claims. Accordingly, the broad teachings of Lang et al anticipate the material limitations of the instant claims.

Alternatively, even if the broad teachings of Lang et al are not sufficient to anticipate the material limitations of the instant claims, it would have been nonetheless obvious to one of ordinary skill in the art to arrive at the claimed pH value of the composition in order to provide the optimum cleaning properties to the composition

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since Lang et al teach that the amount surfactant, water, chitosan and other required components added to the composition may be varied.

Claims 1-6, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garris (US 5,776,876).

Garris teaches effective, multi-use filter cleaning compositions including 5% to 60% of a strong acid, 1 to 40% of a surfactant and 0.5% to 20% of a sequestrant/builder. The compositions optionally include 0.5% to 10% of a water soluble organic solvent, and/or 0.5% to 10% of nonionic surfactant. See Abstract. Suitable surfactants include anionic, cationic such as various quaternary ammonium chlorides, etc. See column 2, lines 30-55. Organic acids may serve as the builder and suitable acids include citric acid, lactic acid, etc. See column 2, line 60 to column 3, line 10. The compositions may also include a water-soluble polymeric agent as the builder sequestrant and such agents include chitosan, polyvinylamine, etc. Suitable organic solvents include glycol ethers, glycols, alcohols, etc. See column 3, lines 10-35. Examples contain greater than 50% water. See Example 10, 13, etc.

Note that, with respect to the pH as recited by the instant claims, the Examiner asserts that the compositions as taught by Garris et al would encompass compositions having a pH of less than 7 as recited by the instant claims because Garris et al suggest composition containing the same components in the same proportions as recited by the instant claims.

Garris et al do not specifically teach a cleaning composition having the specific pH containing a surfactant, a poly D-glucosamine, water, and the other requisite

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components of the composition in the specific proportions as recited by the instant claims.

It would have been obvious, at the time the invention was made, to formulate a cleaning composition having the specific pH containing a surfactant, a poly D-glucosamine, water, and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, because the broad teaching of Garris suggest a cleaning composition having the specific pH containing a surfactant, a poly D-glucosamine, water, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cauwet et al (US 5,661,118).

Cauwet et al teach a hair and/or skin washing and treatment composition containing, in a cosmetically acceptable medium, at least one anionic surface-active agent, at least one amphoteric and/or zwitterionic surface-active agent, at least one polymer containing cationic groups, at least one ceramide and/or one glycoceramide. See Abstract. Suitable polymers are those derived from chitosan. See column 9, lines 5-35. The pH of the compositions is from 2 to 9, preferably from 3 to 8. Additionally, the compositions may contain nonionic surfactants, thickening agents such as hydroxymethylcellulose, etc. The cosmetically acceptable medium preferably comprises water, but may also contain cosmetically acceptable solvents such as glycol

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ethers. See column 13, line 5 to column 14, line 15. The compositions may also contain dyes, alpha hydroxy acids, anti-dandruff agents, detoxifying agents, etc.

Cauwet et al do not specifically teach a cleaning composition having the specific pH containing a surfactant, a poly D-glucosamine, water, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

It would have been obvious, at the time the invention was made, to formulate a cleaning composition having the specific pH containing a surfactant, a poly D-glucosamine, water, and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, because the broad teaching of Cauwet et al suggest a cleaning composition having the specific pH containing a surfactant, a poly D-glucosamine, water, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10/035318. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-8 of 10/035318 encompass the material limitations of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Remaining references cited but not relied upon are considered to be cumulative to or less pertinent than those relied upon or discussed above.

Applicant is reminded that any evidence to be presented in accordance with 37 CFR 1.131 or 1.132 should be submitted before final rejection in order to be considered timely.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (703) 308-2519. The examiner can normally be reached on Mon. thru Fri. from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (703) 308-4708. The fax phone

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numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

GRD
February 10, 2003

GREGORY DELCOTTO
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read "G. Delcotto", written over the printed name and title.